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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/637,802	05/08/96	SCOTT EN	A 0-100000

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13M1/0422

EXAMINER
PHILIPS, M

ART UNIT	PAPER NUMBER
1304	5

DATE MAILED: 04/28/97

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on 5/8, 9/20/96

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-20 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-20 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☒ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of Reference Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 4

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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Detailed Action

Specification

1. The disclosure is objected to because of the following informalities: "jewellery" is misspelled throughout the specification.

Appropriate correction is required.

2. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

Claim Rejection - 35 USC 112

Claims 1-10 and 13-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 3-10, 13-16 and 20 are incomplete because there is no -- balance silver -- recited. Is the alloy to include silver, or to be silver (colored)?

"Jewellery" is misspelled in claims 1-10, 13-14 and 16. "Jewellerysilver" is misspelled in claim 15. There is no -- . -- at the end of claims 17-20. Claim 20 appears incomplete, as it contains the elements of ex. 2 only up to 0.125 Ge.

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Claims 7-8 are confusing because they do not use conventional Markush language.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1 and 4, 6-9 are rejected under 35 U.S.C. 102(b) as being clearly anticipated over JP 61-34,148.

JP 61-34,148 discloses alloy example 4 comprising 6% Cu, 2% Ge and 4% Zn, ~~OB~~, ~~OIn~~, ~~Os~~n, 86Ag. Differences in statements of the fields of intended use "Jewellerysilver" do not lend patentability to instant composition claims. "Up to 6 Sn" encompasses O, and claims ~~3-9~~ specify O.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

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such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-4 and 6-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 52-23,660.

The reference teaches an alloy with a composition of 1-7 In, 1-7 Cu, 1-5 Sn, 1-4 Zn and 0.7 of an element from a group including Ge, which overlaps instant claimed ranges. See the abstract. *Note claims 7-8 encompass 0% additions.*

The exact amounts of each of the constituents, and all of the various properties recited in applicant's claims are not disclosed in the prior art; however, the prior art compositions overlap those as claimed.

It has been held that one of ordinary skill in the art at the time the invention was made would have considered the claimed compositions to have been obvious because overlapping ranges in a composition is considered to establish a prima facie case of obviousness. See *In re Malagrari*, 182 U.S.P.Q. 549. Further, in view of this overlap in composition, the composition taught by the reference would be expected to possess the same properties of applicant's claimed material. See *In re Best*, 195 USPQ 430.

6. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harigaya et al 3,811,876.

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The references disclose a tarnish resistant silver alloy with 4-10 Sn, 0.5-12 In, 0.1-5 Zn, ~~0.001-10~~ ^{0.001-10} Cu and additions of 0.001-5 from a group including Ge and (0.001-1%), Si. See col. 1, lines 6-14; col 5 lines 25-37; col. 6, lines 1-12, 45 - col. 7, line 23.

The exact amounts of each of the constituents, and all of the various properties recited in applicant's claims are not disclosed in the prior art; however, the prior art compositions overlap those as claimed.

It has been held that one of ordinary skill in the art at the time the invention was made would have considered the claimed compositions to have been obvious because overlapping ranges in a composition is considered to establish a prima facie case of obviousness. See *In re Malagrari*, 182 U.S.P.Q. 549. Further, in view of this overlap in composition, the composition taught by the reference would be expected to possess the same properties of applicant's claimed material. See *In re Best*, 195 USPQ 430.

7. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bernhard et al 5,039,479 in view of Youdelis 4,124,380 and JP 04-224,645.

Bernhard et al discloses an alloy with ranges of 89-93.5 Ag, 0.02-2 Si, 0.001-2¹/₂ ~~0.001-2~~ ^{0.001-2¹/₂} Zn, 0.5-5 Zn 0.5-6 Cu, 0.25-6 Sn and 0.01-1.25% In, which is formed by a method utilizing a master alloy to be alloyed with silver metal, the master alloy including 45 - 76.9 Zn, 2.280 Sn, 4.5 - 9.2 Cu, .05-30¹/₂ Si, 0.01 - 1.2 In and about .001-3.07 B. See the abstract, col 2, lines 10-37; *claim 1*.

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The exact amounts of each of the constituents, and all of the properties claimed "firescale resistant, work hardenable jewelry silver" and Ge are not disclosed by the prior art. However, the prior art compositions otherwise overlap or closely approximate the claimed ranges.

The Bernhard et al reference doesn't disclose utilizing Ge in the silver compositions. However, it is known in the art, as evidenced by Youdelis 4,124,380, that by adding overlapping amounts (0.1-10%) Ge to silver alloys virtual elimination of oxidation occurs. See the abstract. It would have been obvious to one of ordinary skill in the art at the time of instant invention to have utilized overlapping amounts of Ge in Bernhard et al's alloys, because of the deoxidizing accorded by doing so. Bernhard et al's teaching of the master alloy includes adding elements other than silver as a master alloy composition. It would have been obvious to form a composition with Ge, such as is broadly claimed by applicants, which will form a composition that will include from small to significant amounts of Ge, such as Youdelis's 0.1-10% in the resultant alloy, by adding from small to significant amounts, such as would overlap instant claimed ranges because it would form the desired oxide free alloy. This renders compositions which overlap instant claimed ranges obvious for both the alloy and the master alloy of the method.

It has been held that one of ordinary skill in the art at the time the invention was made would have considered the claimed compositions to have been obvious because close approximation or overlapping ranges in a composition is considered to establish a prima facie case of obviousness. See *In re Malagrari*, 182 U.S.P.Q. 549; *Titanium Metals v Banner*, 227 USPQ 773, *In re Nehrenberg*, 126 USPQ 383. Further, in view of this overlap in composition, the

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composition taught by the reference would be expected to possess the same properties of applicant's claimed material. See *In re Best*, 195 USPQ 430.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margery Phipps whose telephone number is (703) 308-2946. The examiner can normally be reached on Mon. - Thurs. from 8:30 to 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Simmons, can be reached on (703) 308-1972. The fax phone number for this Group is (703) 305-7719.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0648.

Margery Phipps/om
April 16, 1997
April 22, 1997

Margery S. Phipps
Margery S. Phipps
Patent Examiner